

REMARKS/ARGUMENTS

Claims 8-13 are canceled without prejudice.

New claim 19 is added to claim the invention in alternative language.

Claims 1-7, 14, and 17 stand rejected under 35 USC §112, second paragraph, as being indefinite. In response to the §112(2) rejection, Applicant respectfully traverses. While the Office Action questions use of "the activity level" in claim 1, 3, 5, 14, and 17, when reading each claim (and as applied in connection with the prior art rejections) the language is sufficiently clear to be understood that "activity levels" are introduced in the monitoring step and that, for example, "the activity level of the first function" refers to one of the activity levels from the monitoring step. Thus, Applicant submits that the §112 rejection is improper. However, in an effort to expedite prosecution, Applicant has amended claims 1 and 14 to more clearly indicate that the functions have respective activity levels that are monitored. Therefore, such amendments are not made for the purposes of patentability, and do not relate to prior art.

Claims 3 and 17 are amended to correct a typographical error: "steps" is changed to "step". These changes are not made for the purpose of patentability because the claims were sufficiently clear as written. In particular, it could be easily seen that "steps" should have been typed as "step" because only a single method step was specified.

Claim 4 is amended to correct a typographical error: "a third function" is change to "the third function". Again, claim 4 as originally typed is sufficiently clear because one could easily determine that "a third function" was previously introduced and that the subsequent reference to "a third function" referenced the previously introduced third function. Therefore, this amendment is not made for purposes of patentability, but is made in an effort to expedite allowance.

Accordingly, the §112 rejections are overcome.

The Office Action fails to show that claim 15 is anticipated by US patent 5,986,467 to Trimberger ("Trimberger") under 35 USC §102(e). The rejection is respectfully traversed because the Office Action fails to show that all the limitations of the claims are taught by Trimberger.

Claim 15 includes the limitations of monitoring activity levels of the functions implemented on one or more PLDs and selectively reconfiguring selected resources of the PLDs in response to activity levels of the functions. The Office Action fails to show that these limitations are taught by Trimberger.

Trimberger teaches determining which PLD is active (Abstract) and configuring the inactive one (col. 2, ll. 18-33). Thus, Trimberger does not teach monitoring activity levels of functions that are implemented on one or more PLDs. There is no suggestion by Trimberger of activity levels, and Trimberger instead teaches determining whether a PLD is active or inactive. Furthermore, there is no mention of functions implemented on a PLD.

The Office Action further fails to show that Trimberger suggests selectively reconfiguring selected resources of the PLDs in response to activity levels of the functions. Trimberger states that a PLD is reconfigured in response to an instruction from an external control source (col. 3, ll. 63-65; col. 5, ll. 18-25). The Office Action does not cite any specific teaching of Trimberger, nor does Trimberger appear to suggest that the reconfiguration is in response to monitored activity levels of functions implemented on the PLD.

For at least the reasons set forth above, the Office Action does not establish that claim 15 is anticipated.

Claims 1-4, and 14-18 stand rejected under 35 USC §103(a) as being unpatentable over US patent application number 2002/0156914 A1 to Lo et al. ("Lo") in view of US patent number 5,999,990 to Sharrit et al. ("Sharrit"). The rejection is respectfully traversed because the Office Action fails to show that all the limitations are suggested by the references, fails to provide a proper motivation for combining the teachings of Lo with teachings of Sharrit, and fails to show that the combination could be made with a reasonable likelihood of success.

As to claim 1, the Office Action has not shown that the combination of references suggests all the limitations of the claims. For example, no showing has been made that Lo teaches monitoring activity levels of functions implemented on one or more PLDs. Lo's controller determines network traffic levels and reallocates bandwidth between paths (para. #27, #30). Sharrit determines a type of required processing and determines which of the RRUs (reconfigurable resource units) may perform the required processing. It is clear that Lo's determining network traffic levels and Sharrit's determining a type of required processing is not suggestive of monitoring activity levels of functions implemented on PLDs. The Office Action is similarly deficient in alleging that the combination suggests the limitations of detecting when the activity level of a first function implemented on a PLD is decreasing; Lo says nothing of functions implemented on PLDs and Sharrit says nothing of monitoring activity levels of functions implemented on PLDs.

The Office Action further fails to show that the combination suggests the limitations of selecting a subset of PLD resources that implement the first function. The Office Action cites Lo's paragraphs 57-58. However, nothing in these paragraphs suggests selecting a subset of PLD resources. Instead, these sections suggest changing the allocated bandwidth in response to rising traffic levels (no mention of PLD

resources). Furthermore, Sharrit does not select a subset of PLD resources that implement the first function, but rather appears to select RRU resources based on availability (col. 9, ll. 25); selecting resources based on availability does not suggest selecting the subset of resources that implement a particular function. The Office Action is similarly deficient in alleging that the limitations of reconfiguring those PLD resources that implement the first function with the configuration bitstream that implements the second function.

The alleged motivation for combining Sharrit with Lo is that "it is obvious ... to combine the teachings of Sharrit and Lo to reallocate the available resource such as bandwidth and/or PLDs as necessary so that dynamically balances utilization of the resource can be achieved." This alleged motivation is improper because it merely restates an objective of Lo. Addressing the "rigorous ... requirement for a showing of the teaching or motivation to combine prior art references," the Court of Appeals for the Federal Circuit recently stated in *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999):

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, (citations omitted), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." (citation omitted)

The alleged motivation is merely a broad conclusory statement of Lo's function, and no evidence has been provided that suggests that teachings of Sharrit would be of any benefit to the Lo system. Specifically, the Office Action has not provided any evidence that Lo's system is lacking in functionality or has

other deficiencies that would motivate a combination with Sharrit. Therefore, the alleged motivation is insufficient to support *prima facie* obviousness.

The Office Action apparently alleges that Lo's system could be combined with the teachings of Sharrit to achieve the claimed invention. The combination would not, however, appear to achieve a reasonable level of success and would appear to render Lo's system unsatisfactory for its intended purpose.

The alleged combination appears to be that Lo's network paths could be combined with Sharrit's different processing functions and that Lo's bandwidth resources could be somehow combined with Sharrit's reconfigurable resource units (RRUs). Using Sharrit's different processing functions in Lo's network path would likely cause problems in Lo by way of changing the function of the network path. Thus, not only would the combination not be reasonably likely to succeed, but the combination would likely cause failure of Lo's network paths by configuring a function other than a network path.

Claims 2-4 further refine the limitations of claim 1 and are patentable over the Lo-Sharrit combination for at least the reasons set forth above.

Claim 14 is an apparatus claim, and to the extent that the limitations of claim 14 are similar to those of claim 1, the Office Action fails to establish a *prima facie* case of obviousness of claim 14 over the Lo-Sharrit combination for at least the reasons set forth above.

The Office Action fails to establish a *prima facie* case of obviousness for claims 15-18 over the Lo-Sharrit combination for at least the reasons set forth above for claims 1-4.

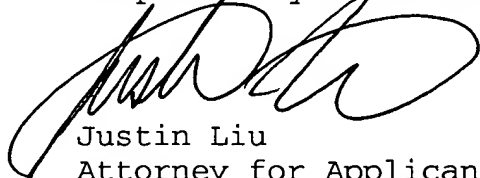
The rejection of claims 1-4 and 14-18 over the Lo-Sharrit combination should be withdrawn because the Office Action fails to show all the limitations are suggested by the combination, fails to provide a proper motivation for combining the

references, and fails to show that the combination could be made with a reasonable likelihood of success.

CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Amendments and Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

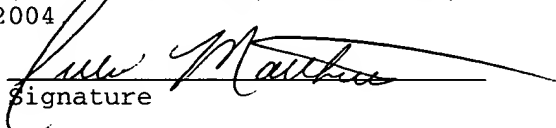
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 25, 2004

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